

## REMARKS

Applicants note that all amendments, cancellations, and additions of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),<sup>1</sup> and without waiving the right to prosecute the cancelled claims (or similar claims) in the future.

In the Office Action dated 10/07/04, the Examiner made two rejections. The rejections are listed below in the order in which they are herein addressed.

- (1) Claims 38-49 are rejected under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement; and
- (2) Claims 40-41 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite.

### I. The Claims are Enabled

The Examiner has rejected Claims 38-49 under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement. The Examiner states that the specification "while being enabling for a method of claim 38 using a eukaryotic cell, does not reasonably provide enablement for a method of claim 38 using any cell..." (Office Action, pg. 3). The applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended Claim 38 to define the cell as a eukaryotic cell. As the Examiner has admitted that such methods are enabled (see above), the Applicants respectfully request that the rejection be withdrawn.

---

<sup>1</sup> 65 Fed. Reg. 54603 (Sept., 8, 2000).

**II. The Claims are not Indefinite**

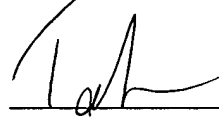
The Examiner has rejected Claims 40-41 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite (Office Action, pg. 5). The Applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have cancelled claims 40-41. As such, the rejection is moot.

**CONCLUSION**

If a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to call the undersigned collect at (618) 218-6900.

Dated: \_\_\_\_\_

12/7/04



\_\_\_\_\_  
Tanya A. Arenson  
Registration No. 47,391

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
(608) 218-6900